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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,508	05/26/2000	Richard T. McNamar	056980/0102	7988

22428 7590 05/04/2004

FOLEY AND LARDNER
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WASHINGTON, DC 20007

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,508

Applicant(s)

MCNAMAR ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22-53,61,66-70,140,142 and 143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22-53,61,66-70,140,142 and 143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicants' communication filed on March 26, 2004. Amendments to claims 1, 22, 23, 50 70 and 140, cancellation of claims 21, 54-60, 62-65, 71-139 and 141 and newly added claims 142-143 have been entered. Claims 1-20, 22-53, 61, 66-70, 140, 142 and 143 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 50-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. In the present instance, independent claim 1 recites the narrow limitation "providing a client with an Integrated Financial management account", whereas dependent claim 50 also recites "providing financial services" which is a broader limitation. Dependent claims cannot have a scope broader than the claim they are dependent on. The amended claim 50 still does not overcome the rejection made in the last office action (Paper No. 7). Similarly claims 51-53 are dependent on claim 50 and hence suffer from the same improper dependency. Cancellation of claims 50-53 is advised in reply to this office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20, 22-49, 61, 66-70, 140, 142 and 143 are rejected under 35 U.S.C. 103(a) as being unpatentable over et al Weiss et al (US Patent 6,131,810) in view of Norris (US Patent 5,870,721 C1) and further in view of Musmanno et al (US Patent 5,826,243).

With reference to claims 1, 70 and 140, Weiss teaches a computer implemented method, a computer data storage medium having program code recorded thereon and a system respectively for providing a client with an integrated financial management account, the integrated financial management account including an investment component linked to a loan component, the method comprising the steps of: receiving application data for the integrated financial management account (See Weiss Claim 1); setting up the integrated financial management account with investment component data and loan component data associated with an account file (See Weiss abstract and claims 5 and 8); contemporaneous with setting up the integrated financial management account in the account file, associating an investment asset to the investment component data in the account file in order to credit the client with the investment asset in the investment component of the integrated financial management account (See Weiss Column 4 lines 37-39); and qualifying the client for a loan in the loan component of the integrated financial management account and recording the qualification in the account file (See

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Weiss Column 14 lines 58-67). A computer data storage medium having program code recorded thereon and a system for providing a client with an integrated financial management account are inherent in the disclosure of Weiss.

Weiss does not explicitly teach the steps of receiving application data online directly from the client; setting up the investment component and loan component associated with an account file at the time of setting up of the integrated financial management account; disbursing the proceeds of the loan component into the investment component after successful loan qualification, or after unsuccessful qualification, removing the association of the investment asset to the investment component data in the account file.

Norris teaches the steps of receiving application data online directly from the client (See Norris Column 2 lines 18-21 and claim 1(a)) and disbursing the proceeds of the loan into the after successful loan qualification (See Norris claim 3). The applicant's account is interpreted to include the investment component of the applicant's account.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the disclosure of Norris to the invention of Weiss. The combination of the disclosures taken as a whole suggests that applicants would have benefited from being able to apply directly without human intervention and thereby maintain their privacy.

Weiss and Norris combined do not explicitly teach the steps of setting up the investment component and loan component associated with an account file at the time of setting up of the integrated financial management account; and after unsuccessful loan qualification, removing the association of the investment asset to the investment component data in the account file.

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Musmanno teaches the steps setting up subaccounts associated with a master account at the time of setting up the master account (See Musmanno Column 1 lines 29-33, 43-46, Column 2 lines 24-39, lines 44-47 and Column 3 lines 23-31) and after unsuccessful loan qualification the master account and subaccounts are closed or not activated (See Musmanno Column 3 lines 43-47). The subaccounts are interpreted to include investment accounts (mutual fund accounts) and loan accounts (margin securities brokerage accounts) and the step of not activating or closing subaccounts is interpreted to include removing the association of the investment asset to the investment component data in the account file.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the disclosures of Musmanno and Norris to the invention of Weiss. The combination of the disclosures taken as a whole suggests that applicants would have benefited from being able integrate credit features with brokerage and mutual fund accounts in a seamless fashion.

With reference to claims 22, 141 and 142, Weiss discloses computer implemented method, a computer data storage medium having program code recorded thereon and a system for providing a client with an integrated financial management account according to claims 1, 70 and 140 respectively, wherein contemporaneous with setting up the integrated financial management account in the account file performing the steps of: displaying detailed insurance options for selection by the client (See Weiss Column 6 lines 62-66, the prompts are interpreted to include insurance options); and associating a portfolio insurance selected by the client with an insurance component data of the integrated financial management account (See Weiss Column 4 lines 36-38 and Column 6 line 62 – Column 7 line 5).

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With reference to claims 2-20, 23-49, 61, 66-69, Musmanno, Norris and Weiss combined disclose a computer-implemented method as discussed above. The limitations in these claims are either taught by the combined disclosures of Musmanno, Norris and Weiss or official notice is taken that such limitations are old and well known in the art and would have been obvious to one with ordinary skill in the art at the time of the invention. These limitations provide the account holders with the convenience of dealing with one account in a user-friendly way, integrated record keeping and also saved them valuable time and money.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the limitations in claims 2-49, 61 and 66-69 to the invention of Weiss. The combination of the disclosures taken as a whole suggests that users would have benefited from the convenience of dealing with one account in a user-friendly way, integrated record keeping and savings of time and money.

Response to Arguments

7. Applicant's arguments with respect to rejection of claims 1-49, 61 and 66-69 under 35 USC § 103 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
April 22, 2004

Richard Weisberger
Primary Examiner